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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,127	05/31/2006	Kikue Hayashihara	HAYASHIHARA ET AL-1 PCT	2612
25889	7590	11/19/2008	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			ABU ALI, SHUANGYI	
		ART UNIT	PAPER NUMBER	
		1793		
		MAIL DATE	DELIVERY MODE	
		11/19/2008	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/596,127	HAYASHIHARA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SHUANGYI ABU ALI	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 August 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) 2,6,7 and 13-17 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3-5, and 8-12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

    1. Certified copies of the priority documents have been received.

    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

Newly submitted claims 2, 6-7, 13-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the liquid clay composition is different from a process of making a liquid clay composition

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 2, 6-7, 13-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. It is to be noted that claim 2 has been amended to define a process and claim 6-7, although still directed to a composition, depend on claim 2, thus it is assumed these claimed should actually define a process in the preamble.

### ***Status of Claims***

Claims 1, 3, 4-5 remain for examination wherein claims 1, 3, 4-5, are amended, and claims 9-12 are new.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What is the equivalent material cited in the claim 3? The phrase "equivalent" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 103***

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

The rejection of claims 1, 3, 4-5 and 8 under 35 U.S.C. 103(a) as being unpatentable over JP 47046212, in view of U. S. patent No. 4,792,357 to Bier as generally set forth in the previous office action mailed 08/18/2008 stands.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 47046212, in view of U. S. patent No. 4,792,357 to Bier.

Regarding claims 9-12, '212 disclose a paint composition comprising wood powder having a length of less than 0.3 mm, CMC such as 3% CMC solution, PVA, pigment and suitable amount of water et al. But they are silent about the composition comprising alginate as applicant set forth in the instant application.( page 2 and example 1-3).

However, it would have been obvious to one of ordinary skill in the art to use alginate in the 212' paint composition, motivated by the fact that Bier, also drawn to a paint composition, discloses that water soluble binder such as cellulose, PVA and alginates are used in the paint composition (col. 4, lines 21-40) and it is *prima facie* obvious to combine two or more materials disclosed by the prior art to form a third material (mixture of CMC and alginate) that is to be used for the same purpose (i.e. as a water soluble binder). In re Kerkhoven 205 USPQ 1069. In addition, all of the above binders are functionally equivalent (i.e. alginate is equivalent to PVA (see Beir)), thus the interchangeability of one functional equivalent material for another is well within the scope of the skilled artisan. In view of this, the interchangeability of PVA defined by the primary reference with alginate is obvious to the skilled artisan, thus the binder of the primary reference would be a mixture of CMC and alginate.

Although '212 is silent about the specific amount of the components used in the composition as applicants set forth in the instant application, it discloses that suitable amount of water is used in the composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by applicants to vary the water amount to change the components amount in the final composition according to the end use of the composition (page 2 of the translation).

### ***Response to Arguments***

Applicant's arguments filed 08/18/2008 have been fully considered but they are not persuasive.

Applicant argues that JP 47046212 does not disclose the information listed by the Examiner in the previous office action. The Examiner respectfully submits that the portion of the paragraphs in the original JP Patent is col. 1, lines 20-25 and col. 2, lines 15-30. The portion of the paragraphs in the English translation document is in page 2 and page 4. As outlined in the previous rejection, all of the claimed limitations are met and applicants show no evidence to the contrary (see full translation of document).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793

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